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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,407	11/18/2003	Vander R. Alves	SVL920030047US1	7238
47069	7590	05/18/2006	EXAMINER	
KONRAD RAYNES & VICTOR, LLP			MORRISON, JAY A	
ATTN: IBM54			ART UNIT	
315 SOUTH BEVERLY DRIVE, SUITE 210			PAPER NUMBER	
BEVERLY HILLS, CA 90212			2168	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/717,407	Applicant(s) ALVES ET AL.	
	Examiner Jay A. Morrison	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/18/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-30 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 19-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 19-27, these claims clearly recite a “an article of manufacture comprising a computer program usable medium”, which may comprise “data transmission devices” (from the detailed description, page 12, line 17). However data signals are not tangible, and cannot tangibly embody a computer program or process since a computer cannot understand/realize (i.e. execute) the computer program or process when embodied on the data signal. Computer program or processes are only realized within the computer when stored in a memory or storage element. Therefore, a data signal does not meet the “useful, concrete, and tangible” requirement as set forth in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02, and hence claims 19-27 are non statutory under 35 U.S.C. 101.

As per claim 28-30, these claims clearly recite “a data signal embodied in a carrier wave”. However these data signals are not tangible, and cannot tangibly embody

a computer program or process since a computer cannot understand/realize (i.e. execute) the computer program or process when embodied on the data signal. Computer program or processes are only realized within the computer when stored in a memory or storage element. Therefore, a data signal does not meet the "useful, concrete, and tangible" requirement as set forth in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02, and hence claims 28-30 are non statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

4. Claims 1,10,19,28 contain the trademark/trade name XA Transaction Manager and XA Transaction Protocol. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is also used to identify/describe a standard that can change over time and, accordingly, the identification/description is indefinite.

5. Claims 6,15,24,30 contain the trademark/trade name XA Transaction Protocol Interface. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is also used to identify/describe a standard that can change over time and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,5-6,8-10,14-15,17-19,23-24,26-28,30 are rejected under 35 U.S.C. 102(b) as being anticipated by Tandon (Patent Number 6,233,587).

As per claim 1, Tandon teaches

"registering said user-defined operation with said database" (column 7, lines 43-51);

"executing said database transaction" (column 8, lines 10-21);

"enabling said database to operate as an XA Transaction Manager by means of said XA Transaction Protocol" (column 7, lines 4-10; column 8, lines 10-21; column 12, lines 18-28);

"accessing a resource manager by said database operating as said XA Transaction Manager" (column 8, lines 10-21; column 12, lines 18-28);

"invoking said user-defined operation as part of said database transaction" (column 8, line 42 through column 9, line 17);

"recording with said database that said user-defined operation has been invoked" (mapping, column 10, line 12 through column 12, line 5);

"executing said invoked and recorded user-defined operation while executing said database transaction" (column 8, line 42 through column 9, line 17);

"and accessing said computer resource by said resource manager, thereby extending said database transaction" (column 8, line 42 through column 9, line 17).

As per claim 5, Tandon teaches

"executing said database transaction comprises a transaction manager external to said database initiating said database transaction" (column 6, lines 19-37).

As per claim 6, Tandon teaches

"said recording is completed with an XA Transaction Protocol Interface" (column 12, lines 18-28).

As per claim 8, Tandon teaches

"said resource manager manages a distributed computer resource" (column 6, lines 19-37).

As per claim 9, Tandon teaches

"said resource manager manages a local computer resource" (column 6, lines 19-37).

As per claim 10,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 1 and is similarly rejected.

As per claims 14-15,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 5-6 and are similarly rejected.

As per claims 17-18,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 8-9 and are similarly rejected.

As per claim 19,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 1 and is similarly rejected.

As per claims 23-24,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 5-6 and are similarly rejected.

As per claims 26-27,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 8-9 and are similarly rejected.

As per claim 28,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 1 and is similarly rejected.

As per claim 30,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 6 and is similarly rejected.

Claim Rejections - 35 USC § 103

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-4,7,11-13,16,20-22,25,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tandon (Patent Number 6,233,587) as applied to claims 1,10,19, and 28 respectively, above, and further in view of Kleewein et al. ('Kleewein' hereinafter) (Patent Number 5,953,719).

As per claim 2,

Tandon does not explicitly indicate "said database transaction is a single-phase transaction".

However, Kleewein discloses "said database transaction is a single-phase transaction" (column 5, lines 13-30).

It would have been obvious to one of ordinary skill in the art to combine Tandon and Kleewein because using the steps of "said database transaction is a single-phase transaction" would have given those skilled in the art the tools to improve the invention by adaptively control which type of which type of commit protocol is used. This gives the user the advantage of having more choices to ensure data integrity.

As per claim 3,

Tandon does not explicitly indicate "said database transaction is a two-phase commit transaction".

However, Kleewein discloses "said database transaction is a two-phase commit transaction" (column 6, lines 30-38).

It would have been obvious to one of ordinary skill in the art to combine Tandon and Kleewein because using the steps of "said database transaction is a two-phase commit transaction" would have given those skilled in the art the tools to improve the invention by adaptively control which type of which type of commit protocol is used. This gives the user the advantage of having more choices to ensure data integrity.

As per claim 4,

Tandon does not explicitly indicate "executing said database transaction comprises an application program initiating said database transaction".

However, Kleewein discloses "executing said database transaction comprises an application program initiating said database transaction" (column 3, lines 17-29).

It would have been obvious to one of ordinary skill in the art to combine Tandon and Kleewein because using the steps of "executing said database transaction comprises an application program initiating said database transaction" would have given those skilled in the art the tools to improve the invention by enabling an application program. This gives the user the advantage of being able to call database procedures from a customized application.

As per claim 7,

Tandon does not explicitly indicate "said invoking said user-defined operation is completed with a data access module".

However, Kleewein discloses "said invoking said user-defined operation is completed with a data access module" (column 4, lines 7-18).

It would have been obvious to one of ordinary skill in the art to combine Tandon and Kleewein because using the steps of "said invoking said user-defined operation is completed with a data access module" would have given those skilled in the art the tools to improve the invention by enabling synchronization of multiple databases. This gives the user the advantage of insuring the integrity of distributed databases.

As per claims 11-13,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 2-4 and are similarly rejected.

As per claim 16,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 7 and is similarly rejected.

As per claims 20-22,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 2-4 and are similarly rejected.

As per claim 25,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 7 and is similarly rejected.

As per claim 29,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 3 and is similarly rejected.

Conclusion


10. The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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